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10/743,864	12/24/2003	Hideyuki Nojiri	246871US3DIV	9345

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EXAMINER

DESAI, ANISH P

ART UNIT PAPER NUMBER

1771

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/743,864

Applicant(s)

NOJIRI, HIDEYUKI

Examiner

Anish Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 8, 10, 11 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The applicant's arguments in response to the Office action dated 05/03/06 have been fully considered.

1. Claims 1-5,7,8,10,11,13-19 are pending. Claims 6,9, and 12 are cancelled.

Claims 13 and 14 are withdrawn.

2. All of the art rejections are withdrawn in view of the present amendments and response (see pages 2-5 of 05/03/06 amendments). However, upon further consideration a new ground of rejection is made in view of Hodgson (US 3,645,835) and Yilgor et al. (US 5,389,430).

3. The obviousness-type double patenting rejections are withdrawn because a terminal disclaimer filed on 05/03/06 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US Patent No. 6,733,856B2 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Objections

4. Claims 3 and 15 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 3 and 15 recite, "wherein the adhesive is applied on one or both of the surfaces of the tape member". Claims 3 and 15 depend from claim 1 and claim 1 recites "a layer of adhesive on at least one of the flat upper and lower surfaces of the tape member".

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Thus claims 3 and 15 essentially repeat the structure of the tape member of

an independent claim 1.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 10 recites "a resiliently stretchable string member having an adjustable length and having arcuate upper and lower surfaces...in an original unstretched state". The specification does not seem to support the "string member" having "arcuate upper and lower surfaces" when it is "in an original unstretched state". Does the applicant want to convey that the string member has "arcuate upper and lower surfaces" when it is stretched? The specification (e.g. Figure 4) seems to suggest that the claimed "string member" has "arcuate" shape of "upper and lower surfaces" when the string member is stretched.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-5,7,10,11, and 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2-5,7, and 15-19 recite the limitation "a double eyelid forming tape". Similarly, claim 11 recites "a double eyelid forming string". There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 10 and 11 rejected under 35 U.S.C. 102(b) as being anticipated by Rollins et al. (US 5,340,648).

In this application regarding recitations "wherein the tape member comprises a synthetic resin material which is resiliently stretchable such that even after the tape member is stretched, the synthetic resin material of the tape member allows an amount of recoil back to the original unstretched state of the tape member, and the resiliently stretchable tape member provides a length sufficient to form a fold on an eyelid and width sufficient to form the fold by breaking into the eyelid when the resiliently stretchable tape member is stretched, pressed and adhered to the eyelid" (claim 1) and "wherein the string member comprises a synthetic resin material which is resiliently

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stretchable such that even after the string member is stretched, the synthetic resin material of the string member allows an amount of recoil back to the original unstretched state of the stretch of the string member, and the resiliently stretchable string member provides a length sufficient to form a fold on an eyelid and a width sufficient to form the fold by breaking into the eyelid when the resiliently stretchable string member is stretched, pressed and adhered to the eyelid.” (claim 10), applicant is respectfully reminded that article claims must be structurally distinguishable from the prior art. While features of an article may be recited either structurally or functionally, claims directed to an article must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

The recitations “a resiliently stretchable tape member having an adjustable length” (claim 1) and “a resiliently stretchable string member having an adjustable length” (claim 10) is interpreted as any string or cord or wire that is elastic or formed of an elastic material will read on the claims. Further with respect the recitations “the tape member” having “straight edges” and “string member” having “straight edges”, since the applicant has not explicitly specified whether the “straight edges” are along the entire length and/or width of the “string member” or the “tape member”, any reference teaching a string member and/or a tape with a straight edges in either length and/or width direction will read on the claim.

Rollins teaches a threadlike or ribbonlike elastic strand with a substantially continuous filament of adhesive helically wrapped around the elastic strand (abstract).

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The elastic strand of Rollins as shown in Figures 1-4 has an adjustable length and arcuate upper and lower surfaces. Additionally, the elastic strand of Rollins as shown in Figures 1-4 has a uniform cross section along the longitudinal direction and has straight edges (Figure 1). Further the adhesive 14 is on at least one of the arcuate upper and lower surfaces of the elastic strand of Rollins (see Figure 1). With respect to claim 11, the elastic strand of Rollins has no adhesive on the ends (Figure 1). Accordingly, Rollin anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodgson (US 3,654,835) in view of Yilgor et al. (US 5,389,430).

Hodgson teaches adhesive materials for use on animal bodies especially human bodies for surgical, dermatological or cosmetic use. The examples include surgical drapes, adhesive dressings, strips and sheets, and eyeliners (Column 2. lines 74-75, Column 3. lines 1-5). Additionally, according to Hodgson another preferred use of the present invention is in surgical drapes. These are large flexible sheets, which are provided with a continuous layer of adhesive on at least a part only of one surface (column 7, lines 64-67). Further the Figure 7 of Hodgson shows a surgical drape, which has straight side edges and a uniform cross section. Regarding claim 3, although

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Hodgson does not explicitly teach that the tape member has a width in the range of approximately 1 mm to 3 mm in the original unstretched state, Hodgson teaches that the size and shape of the suture strips may of course be varied as desired (column 8, lines 62-64). Alternatively, it is the examiner's position that choosing a size of a tape involves only a routine skill in the art. See *In re Rose* 220 F.2d 459, 105 USPQ 237 (CCPA 1955). With respect to claims 4, 16, and 17 Hodgson teaches that where only a part of one surface is coated, the adhesive coated area may be varied with the design of the drape and a film or release-coated protector is generally applied to the adhesive-coated area. This protector is removed when it is desired to use the drape. Generally two uncoated margins are provided to enable the protector to be easily removed (column 7, lines 68-73).

Hodgson is silent as to teaching of a resiliently stretchable tape member, however Yilgor teaches water vapor-permeable and waterproof adhesive polymer coated textile materials (abstract). Further according to Yilgor, applications of these coated fabrics cover a wide range of diverse fields such as surgical drapes (column 3, lines 50-61). The textile material (backing) of is formed of an elastically stretchable material (claim 8). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the elastically stretchable material of Yilgor as a backing for the surgical drape of Hodgson because it is known in the art to use elastically stretchable material as a backing for surgical drapes.

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8. Claims 5,7, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodgson (US 3,654,835) in view of Yilgor et al. (US 5,389,430) as applied to claims 1-3 above, and further in view of Clavin (US 4,653,483).

The invention of Hodgson as modified by Yilgor is previously disclosed. Hodgson is silent as to teaching of a release sheet having a breaking point to be broken when being stretched is adhered on one or both of the surfaces of the tape member. However, Clavin teaches cosmetic adhesive tape strips comprising a thin pliable transparent backing material and an adhesive carried on the opposite side surface of the backing material (Column 2, lines 14-17). Clavin further discloses a split peel-off liner 48 with an overlap 56 such that the liner can be split in the middle and removed from the adhesive when the strip is attached to the skin of an upper eyelid (Column 5, lines 1-5). The split peel off liner of Clavin 48 reads on the claimed release sheet having a breaking point. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the split peel off liner of Clavin in the invention of Hodgson, motivated by the desire to protect the underlying adhesive layer. Regarding claim 7, according to Hodgson the protector, when used, may be a smooth-release coated paper, e.g. a silicone-release coated paper (column 6, lines 70-72).

Response to Arguments

9. Applicant's arguments filled on 05/03/06 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

APD

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PRIMARY EXAMINER